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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,746	09/18/2001	Robert Parisi	10251-049	9490
21890	7590	04/13/2006	EXAMINER	
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			RINES, ROBERT D	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/955,746

Applicant(s)

PARISI, ROBERT

Examiner

Robert D. Rines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/30/05, 4/14/06 **82/6/602**
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

*Notice to Applicant*

[1] This communication is in response to the patent application filed 18 September 2001. It is noted that this application benefits from Provisional Patent Application Serial No. 60/233,503 filed 19 September 2000. The IDS statements filed 6 June 2002, 14 April 2003, and 30 June 2005 have been entered and considered.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

[2] Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

[A] First, claim 1 appears to be directed toward an insurance policy. However, it is unclear as to which recognized statutory class of invention the "insurance product" of claim 1 is directed.

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In particular, an "insurance product" is not a process or method, as it lacks a series of steps. An "insurance product" is not a machine or system, as there is no specific recitation of machine or system components. An "insurance product" is not recognized as a composition of matter. An "insurance product" per se is merely a collection of the financial, legal, or administrative rights and obligations of the parties involved. Since these rights and obligations are typically fixed in some tangible medium (e.g., paper), a possible category for a "policy/product" may be "article of manufacture". However, if the claimed insurance policy fails to qualify as an "article of manufacture", the insurance policy is merely a collection of data, which is not suitable for patent protection under 35 U.S.C. 101.

[B] Secondly, under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and tangible result" (*State Street Bank & Trust Co. vs. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)). In general, an insurance policy/product is conceptually useful for securing funds needed after the loss of (or damage to) properties and/or other casualties. However, claim 1, as presently recited, does not appear to have a concrete result. Because the present application is directed to an abstract collection of legal obligations and financial compensation for damages, it is unclear whether the claimed insurance product can be repeatable and predictable (and thus, concrete). Further, the present application serves to generate an insurance policy based on the risks associated with conducting business over the Internet, but the type and nature of coverage are determined by subjective selection of coverage by the consumer and are therefore not repeatable, i.e., concrete.

[C] Lastly, the "insurance product", in and of itself, as recited in claim 1 (as an apparent "article of manufacture") fails to have a tangible result. Claim 1 merely recites non-functional descriptive material, as no recitation of executable code or a data structure is provided. Further, the policy is not explicitly recited as being embodied on any medium. Insurance policies, data structures, or computer programs, in general, that are not claimed as embodied in computer-readable form are descriptive material, per se, and are not statutory because they are not capable of causing functional change in a computer. Thus, the "insurance policy" of claim 1 is not tangibly embodied since it is drawn to the financial, legal, or administrative rights and obligations per se.

[D] In light of the above, it is respectfully submitted that the claimed invention, although useful, does not have a tangible and concrete result, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

[E] Claims 2-9, when analyzed in the same manner described above with respect to claim 1, also fail to represent an active step towards a useful, concrete, and tangible result. Therefore, claims 1-9 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[3] Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by DiMattina (United States Patent #6,405,177).

[A] As per claim 1, DiMattina teaches an insurance product to cover the risks associated with conducting business on the Internet, comprising: a. a first insurance coverage for conducting advertising and marketing business on the Internet (DiMattina; Abstract and col. 2, lines 1-16), b. a second insurance coverage for rendering professional services on the Internet (DiMattina; Abstract and col. 2, lines 1-16), c. a third insurance coverage for protection against a third party liability when conducting business on the Internet (DiMattina; Abstract and col. 2, lines 1-16), d. a fourth insurance coverage for network security when conducting business on the Internet (DiMattina; Abstract and col. 2, lines 1-16), and e. a fifth insurance coverage which combines the protections provided by said first, second and fourth insurance coverages (DiMattina; Abstract and col. 2, lines 1-16).

[B] As per claim 2, DiMattina teaches wherein said first insurance coverage comprises protection for material published, transmitted, disseminated, distributed, serialized, created, originated, exhibited or displayed via the Internet in the course of business (DiMattina; Abstract and col. 2, lines 1-16).

[C] As per claim 3, DiMattina teaches wherein said first insurance coverage further comprises protection for alleged wrongful acts, including libel, slander, product disparagement and trade libel, as well as infringement of copyright, title, slogan, trademark, domain name, trade name, trade dress or service name, and also plagiarism, piracy, misappropriation of ideas under implied contract, and invasion, infringement and interference with rights of privacy and publicity (DiMattina; Abstract and col. 2, lines 1-16).

[D] As per claim 4, DiMattina teaches wherein said second insurance coverage comprises protection for errors and omissions, and for content-based liability (DiMattina; Abstract and col. 2, lines 1-16).

[E] As per claim 5, DiMattina teaches wherein said second insurance coverage further comprises protection for allegations of wrongful acts in the performance of professional services on the Internet (DiMattina; Abstract and col. 2, lines 1-16).

[F] As per claim 6, DiMattina teaches wherein said third insurance coverage comprises protection against a third party liability when a failure of network security causes damage to said third party (DiMattina; Abstract and col. 2, lines 1-16).

[G] As per claim 7, DiMattina teaches wherein said fourth insurance coverage comprises protection against a network security failure caused by a cyber-attack, including coverages for denial of services, loss of intangible assets, E-business interruption, cyber-extortion, computer attack reward, and crisis management. (DiMattina; Abstract and col. 2, lines 1-16).

[H] As per claim 8, DiMattina teaches wherein said first, second, third, fourth and fifth insurance coverages are worldwide (DiMattina; Abstract and col. 2, lines 1-16).

[I] As per claim 9, DiMattina teaches wherein said first, second, third, fourth and fifth insurance coverages can be purchased individually or in any combination (DiMattina; Abstract and col. 2, lines 1-16).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Rines whose telephone number is 571-272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R.D.R.

12/1/05  
12/5/05

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER